

The applicants traverse and disagree with the position taken in the Office Communication for at least the following reasons.

1. There was no omission in the reply filed November 25, 2005 to the prior Office Action and the reply was fully responsive.
2. The applicants are entitled to an Office Action on the merits on the issue of new matter. A new matter rejection in the context of "not fully responsive" is inappropriate in the Office Communication and should be made in an Office Action on the merits.
3. A new matter rejection in an Office Communication in the context of "not fully responsive" deprives the applicants of the statutory right under 35 U.S.C. §134 to appeal the rejection to the Board of Patent Appeals and Interferences.
4. Applicants do not see where 37 C.F.R. §1.111 supports the position in the Office Communication.
5. The applicants submit that the range of "not more than 0.5% Cr" and "not more than 0.5% Mo" is not new matter. However, applicants submitted that providing arguments of fact and law on the issue of new matter is improper in the procedural context of "not fully responsive" and should be made in a response to an Office Action on the merits.

#### **No Omission**

The applicants maintain that there was no omission in the reply filed November 25, 2005 in response to the prior Office Action mailed June 21, 2005. The applicants maintain that the reply filed November 25, 2005 is fully responsive to the Office Action mailed June 21, 2005.

In the reply filed November 25, 2005, the applicants set forth support for the amendment “not more than 0.5% Cr” in claims 1-4 as page 6, lines 11-19 of the specification. In the reply filed November 25, 2005, the applicants set forth support for the amendment “not more than 0.5% Mo” in claims 1-4 as page 6, line 20 to page 7, line 5 of the specification.

There was no omission in the reply filed November 25, 2005. The reply filed November 25, 2005 was not a reply that was “not fully responsive to the prior Office Action” for failing to specifically point out support for the amendments “not more than 0.5% Cr” and “not more than 0.5% Mo”. The applicants specifically pointed out support for these amendments in the reply filed November 25, 2005.

The Examiner is fully entitled to take the position that the amendments directed to the ranges of Cr and Mo are not supported by the specification as originally filed as specifically point out by the applicants and therefore the amendments are new matter. This new matter position, if taken by the Examiner, is a completely different issue from the issue of whether or not the reply filed November 25, 2005 is or is not fully responsive.

This is an issue to be raised in an Office Action. This Examiner’s disagreement with the specific support for the amendments pointed out in the reply by the applicants is completely different from the Examiner taking the position that because he disagrees that the support specifically pointed out by the applicants supports the amendment to the claims, this disagreement by the Examiner converts the applicants reply into being not fully responsive.

#### **Entitled To Office Action**

The applicants maintain they are entitled to an Office Action on the merits with respect to the issue of new matter.

The question of whether or not the specification discloses the amended claimed ranges for Cr and Mo is a legal question governed by 35 U.S.C. §112, first paragraph (written description requirement) and/or 35 U.S.C. §132(a), last sentence (no new matter can be introduced by amendment) based upon the facts of the disclosure of the specification as originally filed.

The applicants maintain that they are entitled to an Office Action on the merits just as the Examiner is entitled to reject the amended ranges for Cr and Mo as new matter under 35 U.S.C. §112, first paragraph and/or 35 U.S.C. §132(a), last sentence, in an Office Action on the merits. The applicants maintain that because the Examiner disagrees with the position of the applicants as to specific support in the specification for the amended ranges for Cr and Mo, the Examiner is not entitled to deem the applicants position in effect a “non-position”, deem the applicants reply as not fully responsive, and refuse to issue an Office Action on the merits.

Just as the Examiner is entitled to reject the amended ranges for Cr and Mo as new matter, the applicants are entitled to respond to the rejection in an Office Action on the merits.

If the Examiner’s rejection is a final rejection, the applicants are entitled under 35 U.S.C. §134 to appeal the final rejection to the Board of Patent Appeals and Interferences.

#### **Applicants Deprived Of Statutory Right**

The applicants are given a statutory right under 35 U.S.C. §134 to appeal a final rejection to the Board of Patent Appeals and Interferences. In the Office Communication, the Examiner takes the position the specific support in the specification the applicants point out for the amended new ranges of Cr and Mo does not, in the opinion of the Examiner, support the new ranges. The Examiner thus deems the applicants’ position to be

“not fully responsive”. Thus, there is no Office Action on merits with respect to a legal and factual issue on which the applicants and Examiner disagree.

The applicants maintain that the Office Communication mailed February 24, 2006 is improper because it deprives the applicants of the statutory right under 35 U.S.C. §134 to appeal a disagreement between the applicants and Examiner with respect to legal and factual issues to the Board of Patent Appeals and Interferences.

**37 C.F.R. §1.111**

The Office Communication say See 37 C.F.R. §1.111. The applicants have reviewed 37 C.F.R. §1.111.

The applicants, as previously stated, pointed out in the reply the specific support in the specification which the applicants maintain support for the amended ranges for Cr and Mo. The Examiner disagrees.

The applicants are unable to find where in 37 C.F.R. §1.111 the Examiner is given the authority, if he disagrees with a position taken by the applicants, to deem the applicants’ position as “not fully responsive” and refuse to issue an Office Action on the merits. There is nothing seen in 37 C.F.R. §1.111 that gives the Examiner authority to dismiss issues of law and fact, as to which the applicants and Examiner disagree, under the proposition that a reply is “not fully responsive”.

The Examiner is requested to point out the paragraph and sentence of 37 C.F.R. §1.111 that supports the Examiner’s position so that the applicants are better positioned to respond.

**Not New Matter**

The applicants are of the opinion that it is not appropriate to discuss the issue of new matter with respect to the amended ranges of Cr and Mo in a response to the Office Communication.

However, the applicants maintain that the amendments “not more than 0.5% Cr” and “not more than 0.5% Mo” are supported in the specification at page 6, lines 11-19 and page 6, line 20 to page 7, line 5 as previously pointed out in the reply filed November 25, 2005.

Furthermore, the specification at page 8, lines 15-25 points out that 0.005 to 0.5% Cr and 0.1 to 0.5% Mo are the effective ranges of Cr and Mo if one skilled in the art desires to add the optional Cr and Mo to the composition for solid solution hardening and precipitation hardening. Applicants disclose by implication at page 8, lines 15-25 that less than 0.005% Cr and less than 0.1% Mo are not effective if it is desired to add the optional Cr and/or Mo to the composition. The entire range of “not more than 0.5% Cr” and “not more than 0.5% Mo” is addressed in the specification. There is no requirement that claim limitations appear verbatim in the specification.

The Court of Customs and Patent Appeals (the predecessor of the Court of Appeals for the Federal Circuit) has made clear that it is not the function of the claims to exclude ineffective reactant proportions. The Court of Customs and Patent Appeals stated in In re Dihn-Nguyen and Stenhagen, 181 USPQ 46, 48 (CCPA 1974):

Disclosure in the specification sufficient to enable practice of the invention by one skilled in the art, taking into consideration obvious modifications of the reactant ratios of specific examples, is all that is required. It is not a function of the claims to specifically exclude either possible inoperative substances or ineffective reactant proportions. (Emphasis in the original).

There has been no showing in the Office Communication that one skilled in the art would not be enabled by the specification to practice the inventions of claims 1 to 4 containing the ranges “not more than 0.5% Cr” and “not more than 0.5% Mo”.

If the Examiner disagrees, this is an issue appropriate for decision by the Board of Patent Appeals and Interferences; not an issue to be deemed a not fully responsive reply, thus divesting the jurisdiction of the Board of Patent Appeals and Interferences to decide the issue and depriving the applicants of the statutory right of appeal under 35 U.S.C. §134.

It is clear that the communication of the Examiner regarding the reply is “not fully responsive” is raising issues of law and fact in an improper procedural context.

### **Summary**

The applicants position is (1) the reply filed November 25, 2005 specifically points out where in the specification there is support for the amended ranges for Cr and Mo, (2) the Examiner is entitled to take the position that the amended ranges are not supported in the specification, (3) the applicants are entitled to an Office Action stating the Examiner’s position, (4) the applicants are entitled to respond to the Office Action, (5) the Examiner is entitled to issue a final rejection (if the prior rejection was not final), and (6) the applicants are entitled to appeal the final rejection for review and decision by the Board of Patent Appeals and Interferences.

### **Telephone Interview**

If the Examiner maintains his position that the applicants reply is not fully responsive, the undersigned attorney respectfully requests a telephone interview with the Supervisory Primary Examiner of Art Unit 1742 and the Examiner.

It is believed that supervisory review would be appropriate because the Examiner's position is depriving the applicants of the statutory right under 35 U.S.C. §134 to have a disagreement between the Examiner and applicants over issues of law and fact decided by the Board of Patent Appeals and Interferences. The telephone interview would be limited only to whether or not the applicants are entitled to an Office Action on the merits with respect to the issue of new matter.

**CONCLUSION**

An action on the merits is respectfully requested.

Respectfully submitted,

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